

REMARKS/ARGUMENTS

Status

In this amendment withdrawn claims 10, 12, 14, 15, 17, 18, 19, 21, 23 and 29 are cancelled without prejudice to future prosecution. Claim 25 is cancelled because it was a substantial duplicate of claim 23.

The invention provides, *inter alia*, a two-layer hydrophilic polymeric material (e.g., latex) in which one layer is free of copper oxide particles, and the other layer comprises copper oxide particles encapsulated in the layer.

Interview

The Applicant thanks Examiner Dodson for the courtesy of a telephonic interview, on short notice, with the undersigned on November 6, 2007. The rejections of record were discussed and the Examiner indicated she would consider Applicant's arguments. The Examiner also indicated she would not consider rejoinder of the withdrawn claims, and in the interest of expediting prosecution those claims are now cancelled.

Objections

The Office objected to claim 25 as a substantial duplicate of claim 23. Applicants have canceled claim 25.

Rejections Under 35 USC 112, first paragraph (Enablement)

Claims 5-9, 28 and 30-37 were rejected under 35 USC 112 as allegedly not enabled. The Office Action stated the specification is enabling for the inactivation of HSV type 1, but does not reasonably provide enablement for inactivation of all viruses.

Initially, applicants note that this is a new rejection and is not necessitated by any amendment by the Applicant. Accordingly the Office Action mailed June 19, 2007 should not have been final. The finality should therefore be withdrawn.¹

The Office Action recognized the specification is enabling "for the inactivation of HSV type 1" but asserts the specification does not reasonably provide enablement for inactivation of all viruses. Applicant respectfully believes the Office has misapplied 35 USC 112, for the reasons explained below.

The Office Action states "the claims are directed to the inactivation of a virus using a multi-layered hydrophobic polymeric material . . ." (Office Action at page 8, last paragraph). However, the claims **are not** "directed to the inactivation of a virus using a multi-layered hydrophobic polymeric material." Such claims would be method claims, and although method claims may be pursued by the applicant elsewhere, they are not the claims now under examination. The claims now being examined are directed to an article of manufacture (e.g., a material), not to a method of inactivating virus. Thus, even if, *arguendo* and contrary to the facts, the device now claimed *was* effective only for inactivation of HSV, the rejection would be improper.

It is undisputed the *claimed* invention is useful (i.e., complies with 35 USC Sec. 101) and that the specification teaches one of skill how to make the device or material (i.e., complies with the enablement requirement of 35 USC Sec. 112). Accordingly, the claims are enabled and this rejection should be withdrawn.

In addition, Applicants respectfully submit the assertions of the prior Office Action would not support a *prima facie* case of non-enablement even for method claims, for at least the following reasons:

- The Office Action asserts "the data present[ed] does not show support for the inactivation of HIV" (Office Action, page 9, first paragraph), but the Office Action provides

¹ Should issues remain unresolved after review of these remarks, and Applicant respectfully requests that the Office contact the undersigned and/or present the issues in a non-final Office Action.

absolutely no basis for this surprising assertion. Applicants respectfully direct the attention of the Office to Example 4A and Figure 1 showing inactivation of HIV.

- The Office Action confuses use of a device to inactivate virus with a "preventive therapeutic" (Office Action, page 9, second paragraph). No method of therapy is claimed. Moreover, the various references by the Office Action to "treatment" of infection (see Office Action, page 8, second paragraph) are not understood.

- The discussion by the Office Action at pages 8-9 of the Office Action is replete with unsupported statements and would fail to support a rejection of any claim, including the claims now pending.

In summary, this rejection should be withdrawn and the claims allowed.

Statutory Double Patenting

The Office asserts claim 5, 6, 8 and 28 claim the same invention as claims 1, 2, 5, 6, 8, 15, 19, 20, 23, 27, 30 and 31 of prior patent No. 7,169,402 B2 (the '402 patent). The present invention is directed to, *inter alia*, "A ***multi-layered*** hydrophilic polymeric material for inactivation of a virus, wherein said polymeric material comprises ***a first hydrophilic polymeric layer having particles encapsulated within***, wherein said particles consist essentially of copper oxide, and wherein said particles release both Cu^{++} and Cu^{+} and a ***second hydrophilic polymeric layer which is substantially free of copper oxide particles***." The claims of the '402 patent do not recite that the material is multi-layered nor that the material comprises a second hydrophilic polymeric layer which is substantially free of copper oxide particles. The instant application and '402 patent do not claim the same invention and applicants respectfully submit the rejection is improper. Moreover, this was a new rejection not warranted by any amendment of the claims, making the finality of the Office Action improper.²

² Thus, as noted above, should issues remain unresolved after review of these remarks, and Applicant respectfully requests that the Office contact the undersigned and/or present the issues in a non-final Office Action.

Provisional Obviousness-Type Double Patenting

The Office has rejected the claims under the doctrine of obviousness-type double patenting in view of App. Nos. 11/648,858 and 10/890,936 (corresponding to US Pat. Pub. 2004/0247653).

App. No. 11/648,858 is a continuation of the '402 patent discussed above. Accordingly, applicants believe the discussion of the '402 patent above also applies to this rejection, and request this rejection also be withdrawn. The multi-layered material now claimed is not an obvious variant of the subject matter of the prior application, but a different and innovative invention.

(In the event the Office is of a mind to maintain the rejection, Applicants respectfully request that the Office provide, with reference to specific claim limitations, the alleged basis for asserting claims are not patentably distinct. The prior Office Actions unsupported assertion that claims are "substantially overlapping" would not (even if true) constitute sufficient basis for a double patenting rejection.)

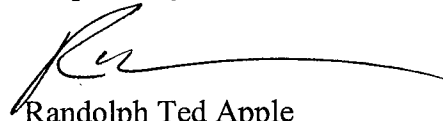
Therefore, Applicants respectfully request this provisional rejection be withdrawn.

With regard to App. No. 10/890,936, the '936 application is a continuation-in-part of the '402 patent discussed above. Similar to the '402 patent, the claims of App. No. 10/890,936 are not directed to a multi-layered hydrophilic polymeric material for inactivation of a virus, wherein said polymeric material comprises a first hydrophilic polymeric layer having particles encapsulated within, wherein said particles consist essentially of copper oxide, and wherein said particles release both Cu^{++} and Cu^{+} and a second hydrophilic polymeric layer which is substantially free of copper oxide particles. Thus, the instant claims are distinct from those of the '936 application and Applicants respectfully request this provisional rejection be withdrawn.

Conclusion

If the Examiner believes a telephone conference would expedite prosecution of this application, please telephone the undersigned at 650-462-5330.

Respectfully submitted,



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